

REQUEST FOR RECONSIDERATION

The Examiner indicated in No. 3 of form PTOL-303 of the advisory action that applicants' proposed amendments which were presented with the reply of June 30, 2008, will not be entered because the amendments raised new issues which would require further consideration and/or search. More specifically, the Examiner explained that "[f]urther search is needed to determine patentability of a method using Formula I and the phototoxic [sic] herbicide."¹)

It is respectfully urged that the Examiner's remark suggests that the Office action of April 25, 2008, was incomplete under the provisions of Rule 112 in conjunction with Rule 104, and/or that the finality of the said Office action was premature.

Applicants' amendment merely canceled claims and presented a previously dependent claim in independent form by introducing the elements of dependent Claim 10 into Claim 1 upon which Claim 10 had depended. Rule 116(b)(1) states:

(b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;

(emphasis added). The changes which were effected in the claims with applicants' reply to the final Office action of April 25, 2008, are therefore deemed to fall within the realm of amendments which may be made after a final rejection has issued.

Moreover, Claim 10 had been presented with applicants' paper of January 27, 2008, along with a reply in compliance with the provisions of Rule 111(a)(1). Accordingly, the subject matter defined in Claim 10, whether presented in dependent or in independent form, had been before the Examiner for search and examination before the final Office action of April 25, 2008, issued. Rule 112 prescribes *inter alia*:

After reply by applicant or patent owner (§ 1.111 or § 1.945) to a non-final action ..., the application ... will be reconsidered

1) Continuation Sheet (PTO-303), lines 5 and 6.

and again examined. The applicant, ..., will be notified if claims are rejected, objections or requirements made, or decisions favorable to patentability are made, in the same manner as after the first examination (§ 1.104). ...

In accordance with Rule 104(a)(1)

... The examination shall be complete with respect both to compliance of the application ... with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

and Rule 104(b) further provides

The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

The Examiner's statement in the advisory action of August 12, 2008, that that "[f]urther search is needed to determine patentability of a method using Formula I and the phototoxic [sic] herbicide"¹⁾ suggests that the final rejection was premature and/or incomplete for failing to meet the provisions of Rule 112 in conjunction with Rule 104(b).

It is therefore respectfully requested that the Examiner withdraw the finality of the Office action of April 25, 2008, and enter and consider applicants' reply as a reply to a non-final Office action, or that the Examiner enter applicants' proposed amendments for purposes of appeal. Favorable action is respectfully solicited. Early action by the Examiner is appreciated.